

### **REMARKS/ARGUMENTS**

This paper is in response to the Office Action of September 7, 2006 and the Examiner is thanked for the careful review of this Application. The due date for response is November 7, 2006.

Claims 1-5, 7-15, 17-21, and 23-25 are pending after entry of the present Amendment.

#### **Claim Rejections - 35 U.S.C. § 103**

Claims 1-5, 7-15, and 17-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of "MiniDisc Manager - WinAmp Playlist Recorder ReadMe" by William Hollingsworth (Hollingsworth), the article "Oscar Mp3 Player (2) Part 2 (final): operation and measurement results" by Kurpiers et al. (Kurpiers), and U.S. Patent No. 6,192,340 by Abecassis. These rejections are respectfully traversed.

Hollingsworth discloses a method to record audio files to a minidisc (MD) using MiniDisc Manager and WinAmp. The method consists of opening MiniDisc Manager and WinAmp. Adding the desired audio files into the WinAmp playlist and manually loading the WinAmp playlist into MiniDisc Manager. Once the WinAmp playlist is loaded into MiniDisc Manager the user can begin recording the audio playback of the MP3 file to the MD.

Kurpiers discloses a stand-alone MP3 player for the playback of MP3 files from a CD. Kurpiers also discloses saving a playlist with MP3 files when creating a CD but fails to disclose the automatic creation of the playlist as claimed by Applicant. Abecassis discloses an apparatus capable of communicating the preferences of a user to an information provider and receiving information from the information provider responsive to the preferences of the user. Additionally, Abecassis can interleave the received information with the preferences of the user.

The cited portions of Abecassis disclose the creation of playlists based on a user's directly prepared and ordered playlist or based on a plurality of user defined criteria As will be shown, the cited references in combination do not disclose or suggest each and every feature of the independent claims.

The combination of Hollingsworth, Kurpiers, and Abecassis do not disclose a method wherein at a time of selecting MP3 files, a playlist is automatically constructed of the selected MP3 files. Particularly, the Examiner relies on the use of Music Match's Auto DJ functionality to created automatic playlists as taught by Abecassis (Colum 15, lines 48-57). As shown in attached Exhibit A, "How to create Playlists with Auto DJ" accessed on November 1, 2006, at <http://www.musicmatch.com/faq/LIB025.htm>, there are two methods to create playlists with Auto DJ. The first method is, "Manually, by selecting the song(s) you wish to play yourself" (Paragraph 1). The second method is "automatically, by using the Audio DJ function." (Paragraph 1)

As will be discussed below, while Exhibit A indicates that playlists can be generated "automatically", the Music Match software requires extensive user interaction to define criteria before a playlist can be compiled "automatically". This is contrary to Applicants' use of the term "automatic" because in the claimed embodiments, the term "automatic" is explicitly defined as not requiring user interaction regarding creation of a playlist.

As described in paragraphs 3-9 of Exhibit A, the user is required to manually enter a variety of criteria that enables the Auto DJ function to compile a playlist. As shown in Exhibit A, some of the listed criteria that must be defined are: the temporal duration of the playlist (Paragraph 3), the general type of music (Paragraph 5), and the specific music the user wants to hear (Paragraph 6). Additional user interaction is required before the playlist is generated as demonstrated in paragraph 8 where it is stated that, "before the playlist is created the user must

click the "Get Tracks" button." Another aspect disclosed in Exhibit A necessary for the proper functionality of Auto DJ is found in paragraph 1 where it is stated that, "For Auto DJ to function accurately, please be sure that your track tags are filled in and correct."

Even using the first method where a user selects the song(s), both Abecassis and the Exhibit A are silent regarding the automatic construction of a playlist of the selected MP3 files to be executed from the destination optical media. Examining the second method, the method relied upon by the Examiner, it is clear that the automatic playlist generation disclosed by Abecassis is not analogous to Applicant's claimed invention. Where Applicants claim automatically creating a playlist to be recorded to the destination optical media, the cited portions of Abecassis are teaching how to generate playlists based on defined user criteria such as playlist duration, general music type and specific music the user wants to hear. Furthermore, the functionality of Abecassis is dependent on completed and accurate track tags. Thus, the playlists created by Applicants' claimed invention and those created using the cited teachings of Abecassis are entirely different regarding how the playlists are created and the contents within the playlist. The functions taught by Abecassis are therefore different than the functions claimed.

For example, using Applicants' claimed invention would result in a user selecting MP3 files from a source to be recorded to a destination optical media. Simultaneous to the selection of the MP3 files, a playlist would be automatically constructed of the selected MP3 files. The construction of the playlist of the MP3 files to be recorded to the optical media occurs without requiring user interaction because the playlist is constructed as the MP3 files are selected by the user. On the other hand, the automatic creation of a playlist as taught by Abecassis requires a plethora of user interaction. The first user interaction requires that the user to check and ensure the accuracy and completeness of the track tags for all the audio files. Additionally, with

Abecassis, the user must define the length of time for the playlist and may specify particular songs to be added to the playlist. The Abecassis user is also required to define particular genres, this portions is why the accurate and complete track tags are required, and finally the user must manually interact with Auto DJ by clicking the "Get Tracks" button.

In view of the foregoing, Applicants respectfully submit that the combination of Hollingsworth, Kurpiers, and Abecassis does not teach or suggest all aspects of Applicants' claimed invention. Applicants respectfully request that the section 103(a) rejections with respect to independent claims 1, 10, 15, and 21 be withdrawn. In addition, the dependent claims are submitted to be allowable for at least the reasons discussed above for the independent claims.

Applicants also believe that the Examiner's proposed combination changes the principle of operation of the Hollingsworth reference contrary to MPEP 2143.01 VI. The Examiner states that it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Hollingsworth and Kurpiers for the purpose of keeping track of the large amount of media files that can be contained on the CD. However, the teachings of Hollingsworth are focused on recording audio sounds to a minidisc while the teachings of Kurpiers are focused on recording MP3 files to a CD. A change in the principle of operation of Hollingsworth based on the difference between recording audio sounds and recording MP3 files is discussed below.

The files recorded to the minidisc using the teachings of Hollingsworth are no longer MP3 files. Rather, with Hollingsworth, the MP3 files are played back on a computer and the resulting sound output is captured by the minidisc recorder as audio data using an analog or digital connection. The type of recording performed using the teachings of Hollingsworth results in a one-to-one time ratio for recording MP3 playback on the minidisc. Therefore, a user

wanting to record 80 minutes of music to a minidisc will be waiting 80 minutes for the recording to finish.

Kurpiers, on the other hand, teaches writing actual MP3 files onto a CD. Using the method disclosed in Kurpiers, hundreds of MP3 files totaling hundreds of hours of music can be recorded to a single CD. The time required to record the MP3 files to the CD is determined by the speed of a user's CD-R/W drive. Current 52X CD recording drives are able to sustain read/write rates between 3.3 and 7.8MB/sec. Assuming an average sustained read/write speed of 5.6MB/s a 700MB CD could be recorded in slightly over two minutes. To record the same MP3 files to a minidisc using the method disclosed by Hollingsworth would require the hundreds of hours defined by playback of every MP3 file and saving the resulting audio data to a minidisc. Applicants believe that the Examiner's proposed combination changes the principle of operation of the Hollingsworth because the Examiner is attempting to combine a reference requiring a one-to-one recording ratio with a reference without a one-to-one recording ratio. Applicants believe this proposed combination changes the principle of operation and is contrary to MPEP 2143.01 VI.

In view of the foregoing, Applicants respectfully submit that the pending claims are in condition for allowance and therefore respectfully request a notice of allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 774-6911. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. ROXIP204). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, LLP

A handwritten signature in dark ink, appearing to read 'K. Chan', with a long horizontal flourish extending to the right.

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**How to create Playlists with Auto DJ**

There are two ways to create Playlists: Manually, by selecting the song(s) you wish to play yourself, or automatically, by using the Audio DJ function. For Auto DJ to function accurately, please be sure that your track tags are filled in and correct.

To use Auto DJ, press the Auto DJ button in the Music Library.

In the (1) Enter Play Time field, enter in the number of hours you would like your Playlist to be. Entering the number '1' will create 1 hour of Playlist music.

The next section (2) is where you define what type of music to put into the Auto Playlist.

In the left hand column, decide the general type of music, or Criteria, with which to create the Playlist. Click any round button to the left. A list of available music options will be displayed to the right.

Next check the check box(es) to the right to tell Auto DJ what specific music you want to hear. A list of all available track titles, or music preferences, will be available according to the Criteria you chose.

After you have made your selections click the Preview button to view the number of songs to be added to the Playlist, and the total play time. By clicking the up and down arrows to the left of the Preview button you can scroll through the specific songs selected.

To create the Playlist, click the Get Tracks button.

To further define your Playlist use the second and third criteria boxes. For example, select only "Classic Rock" titles with a preference rating "Excellent" (second criteria) and which are appropriate for "Party" situations (third criteria). You may select more than one category in a criteria choice simply by holding in the Ctrl button on the keyboard and clicking on multiple categories.

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EXHIBIT A